

First, MPEP 806.05(d) provides, “Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants” (emphasis added). In the present Office Action, the Examiner has not carried his burden of explaining how the alleged separate subcombinations (i.e., the original claims vs. the new claims) are supposedly separately usable. The Examiner simply states his conclusion without supporting it with any explanation or facts, except what the Examiner wrongly characterizes as an “admission” by Applicants (discussed below).

Second, for purposes of restriction/election, it is the claimed invention that must be evaluated for utility. The “invention” is defined by a claim as a whole, not by any of its particular limitations in isolation. In the present Office Action, the Examiner improperly focuses on a particular claim limitation in certain claims as defining the utility of those claims, rather than evaluating the claimed subject matter as a whole.

Consequently, the Examiner seems to disregard the clear overall similarities between new claims 43-84 and original claims 1-42, and to focus instead on the differences. For example, note the similarities between claim 1 (canceled) and new claim 43:

Claim 1	Claim 43
1. (Canceled) A method for operating an electronic mail server system having mailboxes associated with message client devices, the method comprising:	43. (New) A method for operating an electronic mail server system having mailboxes associated with message client devices, the method comprising:

receiving input to change a mailbox, said input comprising at least one of a new mail message and a request to change an organizational structure of said mailbox;	receiving input to change a mailbox, the input comprising a request to change an organizational structure of the mailbox;
making appropriate changes to said mailbox in response to said input; and	making a change to the mailbox in response to the input; and
sending a message to a message client device associated with said mailbox, said message comprising information to allow said message client device to synchronize a cached version of said mailbox stored locally in said message client device with said mailbox.	pushing a message to a wireless client device associated with the mailbox, wherein the information is used by the wireless client device to synchronize a cached version of the mailbox stored locally in the wireless client device with the mailbox prior to notifying a user of the change to the mailbox.

From the above side-by-side comparison, it is apparent that at least claim 43 is clearly similar enough to (at least) original claim 1 that the current action by the examiner is improper. The subject matter of these two claims (at least) could easily be covered in the same search. In fact, a properly formulated search of claim 1, if it was not unduly restrictive, should have identified the best prior art (if any) relative to new claim 43.

By the Examiner's questionable "logic", almost any amendment that alters the scope of a claim in any way, after initial examination, would be subject to restriction and therefore could be denied entry. Clearly that would be an absurd and incorrect result.

Furthermore, the Examiner wrongly characterizes Applicants previous arguments as an "admission" that supports his position. Specifically, the Examiner states:

These different utilities are also admitted by the applicant in the Response to Amendment submitted on 6/13/2005 (pages 12-13 of the remark argued that 'emailing/sending a message' is different from 'pushing a message' and Reed reference, although taught about emailing

messages to users and other notification methods, does not teach 'pushing messages'. See specifically lines 17-21 of page 13).

Applicants disagree. Whether or not a particular claim limitation is disclosed in a cited reference is not relevant to the claimed invention's utility. The Examiner seems to confuse principles of prior art/novelty with principles of utility. Applicants' argument that a particular claim limitation is not disclosed in a cited reference is not the same as, has nothing to do with, and is not an admission regarding, the utility of the claimed invention.

The withdrawal of claims 43-84 in the present Office Action was clearly in error, for the above-stated reasons. Therefore, Applicants respectfully request reconsideration of the present application based on the amendment and remarks filed on June 13, 2005.


If there are any additional charges, please charge Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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Jordan M. Becker
Reg. No. 39,602

Customer No. 26529
12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025
(408) 720-8300